

REMARKS

GENERAL OBJECTIONS AND 35 USC 112

The Examiner objects to the abstract as not being on a separate page by itself. A new abstract is attached herein as **Appendix A**, and the Applicant respectfully requests that the Examiner replace the original specification with this version. There is no new matter added by virtue of this amendment.

Claims 27 and 41 have been amended to correct dependency.

Claims 57, 75 and 76 have been canceled for other reasons, and therefore, this objection is mooted.

35 USC §§102 AND 103

The Applicant, first, would like to correct the record on the issue of ethyl lactate being used as a solvent in this matter. The Examiner has taken a position that since the Applicant mentions ethyl lactate in the claims that an argument by the Applicant stating that ethyl lactate is not preferred in some cases is incorrect and not acceptable. The Applicant respectfully requests that the Examiner consider the specification again, especially pages 9 and 10, along with the Examples. The Applicant states in those sections that when using a “novolac-based polymeric solution” that ethyl lactate is not preferred, because it is strongly hydrogen bonding. Example 10 completely confirms this statement – given that Example 10 shows data collected when comparing a novolac-based polymer composition comprising ethyl lactate and not comprising ethyl lactate. The Examiner’s blanket statement regarding ethyl lactate is not completely correct. Therefore, the Applicant respectfully requests that the Examiner reconsider this position and realize that in some embodiments, where a combination of structural constituents are included, that ethyl lactate may be desirable in combination with other solvents – as stated in the claims where the phrase “and combinations thereof” is used repeatedly.

Second, the Applicants note that the canceled claims herein are canceled in order to provide a smaller set of allowable claims and will pursue the canceled claims, in their entirety, through a divisional application. The canceled claims herein are not canceled to remove any references, but are instead canceled in order to focus the Examiner on a smaller set of claims in the hopes of expediting allowance.

Turning to the claim rejections cited herein, the following rejections have been removed, by virtue of the amendments presented herein where claims 1-17 are canceled and the provisions of claim 18 are incorporated into the remaining independent claims (and dependent claims, by virtue of their dependency):

Claims 1-5, 8-17, 26-29, 32-40, 43-55, 57-62 and 64-76 are rejected under 35 USC 102(b) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Drage

(US 5858547).

Claims 1-5, 7-17, 26-29, 32-40, 42-55, 57-61 and 63-75 are rejected under 35 USC 102(b) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Rahman et al (US 5928836).

Claims 1-3, 8-10, 26, 28-29, 32-33, 36-38, 43-44, 47 and 53-55 are rejected under 35 USC 102(b) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Montgomery (US 6258514).

Claims 1-3, 8-14, 26, 28-29, 32-33, 36-38, 43-49 and 53-55 are rejected under 35 USC 103(a) as obvious over Montgomery (US 6258514).

Claims 1-5, 7-17, 26-29, 32-40 and 42-55 are rejected under 35 USC 102(b) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Rogler (US 5276126).

Claims 1-2, 8-14, 26, 28-29, 32-33, 36-37, 43-49 and 53-56 are rejected under 35 USC 102(b) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over McCutcheon et al. (US 2007/0105384).

Claims 1-5, 7-17, 26-29, 32-40, 42-55, 57-61 and 63-75 are rejected under 35 USC 102(b) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Hacker et al. (US 6723780, 6506831, 6506441).

Claims 1-17, 26-29, 32-55 and 57-75 are rejected under 35 USC 103(a) as obvious over Hacker et al. (US 6723780, 6506831, 6506441).

Claims 1-3, 8-14, 26, 28-29, 32-33, 36-38, 43-49 and 53-56 are rejected under 35 USC 102(b) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Prybyla (US 6048799).

The Applicants respectfully request that all of the above-referenced rejections be

removed from consideration, as they are now rendered moot by various canceled claims and amended claims.

Finally, in review of the remaining rejections, the Applicants respectfully disagree with the following and ask that the Examiner reconsider.

Claims 1-21, 23-55, 57-62 and 64-76 are rejected under 35 USC 103(a) as obvious over Drage (US 5858547).

Claims 1-55 and 57-75 are rejected under 35 USC 103(a) as obvious over Drage (US 5858547) in view of Rahman et al (US 5928836).

Claims 1-21, 23-62 and 64-75 are rejected under 35 USC 103(a) as obvious over Drage (US 5858547) in view of McCutcheon et al (US 2007/0105384) or Patil et al. (US 2003/0207209).

Claims 1-55 and 57-75 are rejected under 35 USC 103(a) as obvious over Hacker et al. (US 6723780, 6506831, 6506441) in view of Drage (US 5858547).

The Applicant respectfully disagrees with all of these rejections.

Claim 18 recites: " A planarization composition, comprising: a o-cresol-based polymer compound and a resol phenolic resin; at least one surfactant; and a solvent system comprising at least one alcohol and at least one ether acetate-based solvent."

Claim 36 contains similar provisions as the ones in Claim 18.

First, the Drage reference only contemplates utilizing a low molecular weight novolac resin and does not contemplate utilizing a resol phenolic resin in addition. This additional resin is not contemplated, recited, disclosed or otherwise utilized in Drage. The Hacker references also include a novalac resin, and in these patents, other components

are intentionally removed to form the solution, which appears to directly contradict claims 18 and 36. Once these two patent families are properly removed as references, the remaining secondary references fail to be relevant.

Second, the Examiner is not clear in the actual rejection based on Drage, Hacker or Rahman. For example, the Examiner states:

“Claims 1-5, 8-17, 26-29, 32-40, 43-55, 57-62 and 64-76 are rejected under 35 USC 102(b) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Drage (US 5858547). “

And then:

“Claims 1-21, 23-55, 57-62 and 64-76 are rejected under 35 USC 103(a) as obvious over Drage (US 5858547).”

These statements appear to contradict one another, given that claims included in the second rejection are not included in the first rejection. The Examiner made similar contradictory statements with respect to the Hacker patents and Rahman.

The Applicant respectfully requests that the Examiner take a fresh look at this case, the claims amendments and the references and contact the undersigned attorney-of-record immediately to resolve any remaining issues (if any) in order to expedite this case.

CONCLUSION

The Examiner cites several references that refer to novolac polymers with a solvent or combination of solvents as part of the solution. The Examiner considers these references to render the current claims unpatentable. The Applicant respectfully requests that the Examiner review the current application closely. The Applicants call out the compounds in many of these references as suitable compounds to use, but clearly points out that all of these references are producing compositions that are not the same or superior to the ones produced in the current application.

It's not enough to merely combine solvents with polymers and form a composition. The Applicants suggest that thoughtfully and strategically combining solvents in order to affect properties of the composition and provide many examples of how contemplated compositions are superior to reference compositions for this reason.

The undersigned Attorney-of-Record respectfully requests an interview to resolve any remaining issues the Examiner has after review of this response, in order to avoid additional and lengthy written prosecution. Dr. Thompson is available during the week from 8AM to 4PM PST and can be reached at 949-224-6282.

REQUEST FOR ALLOWANCE

Claims 18-22, 24-27, 30-36, 39-49 and 51-56 are pending in this application, and the Applicant respectfully requests that the Examiner reconsider the claims in light of the arguments presented and allow all pending claims.

Respectfully submitted,

Buchalter Nemer, A Professional Corp.



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By:

Sandra P. Thompson, PhD, Esq.
Reg. No. 46,264
E-mail: sthompson@buchalter.com
Direct Line: 949-224-6282

ATTORNEYS FOR APPLICANT(S):

Buchalter Nemer, A Professional Corporation
18400 Von Karman Ave., Suite 800
Irvine, CA 92612
Fax: 949-224-6203

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Appendix A